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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,912	04/27/2001	Takanori Tomioka	57454-096	8376
7590	04/08/2005		EXAMINER	
McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			GRAYSAY, TAMARA L	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/842,912	TOMIOKA, TAKANORI
	Examiner	Art Unit
	Tamara L. Graysay	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 April 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1 page</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____

DETAILED ACTION

Requirement for Information

The following is a quotation of 37 CFR 1.105(a)(1)(iii) – (vii) and 37 CFR 1.105(a)(2):

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (iii) *Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) *Information used in invention process*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.
- (vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.
- (vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

Only for purpose of this requirement for information, the defective level is presumed to be something other than zero / no defect.

1. In response to this Office action, applicant and/or assignee is required to present information related to the claimed method of selling a memory device that has been analyzed as having a defective level. If a memory device is defective, how can it be sold?

Applicant and/or assignee is required to provide information as to how a memory device is fit for sale when it has been analyzed and the results of the analysis reveal that the memory device has a defect. This requirement is made based on the prior art search that consistently revealed that faulty or defective memory devices are unusable and not fit for sale.

Further, since it appears that the sale of defective memories is against public policy, as discussed in the Wall Street Journal article (Advanced micro says FBI is probing sale of firm's

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faulty chips), applicant and/or assignee is required to provide information as to whether or not the sale of a defective memory device is against public policy.

The required information is to be relevant, and include but not be limited to, the examples of information listed in 37 CFR 1.105(1)(a)(iii) through (vii): related information, information used to draft the application, information used in the inventive process, identification of what is being improved, and use of the claimed invention at the time the application was filed.

Drawings

2. The drawings are objected to because of the following: They fail to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "S105" (Fig.2); and "S19" (Fig.7).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: The sentence at page 2, lines 11-12, seems to contain a grammatical error in that it does not make sense. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-10, as broadly claimed, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In the present application, the claims include a method for selling a defective memory device comprising the steps of saving information related to the analysis of memory device performance and searching the results of the memory device performance analysis. The examiner points out that a memory device having a defect will not work and is unusable, i.e., a memory device is either defective or not defective, either usable or unusable, as described in U.S. Patent 5353425 to Malamy (column 1, lines 43-58). The Malamy patent is cited as being representative of the prior art information found by the examiner.

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Therefore, the method as claimed is not capable of being performed and is nonenabling because a memory device having a level of defectiveness greater than zero is unusable, i.e., not fit for sale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (US-4992940) in view of Hayes (US-5781721).

Dworkin discloses an apparatus and method for selling products. The apparatus includes a database containing information and a search unit contained within the CPU for retrieving product information that matches a buyer's search criteria.

Hayes teaches analyzing a memory device (abstract) and storing the results of the memory device analysis. The memory device information is used for determining whether a memory device is defective.

The examiner takes Official notice that the sale of defective or imperfect products is widely known in the business of product sales and that the degree of acceptance by a purchase for a particular defective product varies dependent on, for example, the type of product and the needs of the purchaser. If memory devices are capable of having a level or degree of

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defectiveness, as alleged by applicant, then the widely known sale of defective or imperfect products would apply to the sale of memory devices.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dworkin to include data related to the defects of a memory device, such as taught by Hayes, in order to offer memory devices for sale that are capable of use by a purchaser even though they contain some defects.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hille (US-5555249) teaches memory device testing.
- Olarig (US-2002/0066052) teaches reduction of errors in a memory device.
- Tabata (US-6154862) teaches a testing device used for testing a memory device, the testing device having a defect/failure analysis memory.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamara L. Graysay
Examiner
Art Unit 3623

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